

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Paragraph 1 of the Official Action implicitly concedes that pages 2-12 of the present Official Action are substantively identical to pages 2-12 of the previous Official Action. Please incorporate by references pages 2-8 of the *Response* filed April 17, 2009 (received by OIPE April 20, 2009).

In section 3 of the "Response to Arguments" section, the Official Action argues that it would have been obvious to replace Yamazaki's gold with Fujieda's iron citing a concern over cost (pages 15-16, Paper No. 20091026). The Applicant respectfully disagrees and traverses the assertions in the Official Action. The claimed invention cannot be achieved by merely replacing the gold of Yamazaki with the iron of Fujieda. The conductive particle 214 of Yamazaki has a surface plated by a material such as gold (see paragraph [0066]); whereas, the present claims recite "fine particles of a soft magnetic material." The Official Action has not demonstrated why one of ordinary skill in the art at the time of the present invention, upon review of Yamazaki and Fujieda,

would have necessarily had a reason to modify Yamazaki's gold-plated particles 214 in view of Fujieda in order to form "fine particles of a soft magnetic material."

In section 4 of the "Response to Arguments" section, the Official Action asserts that "Fujieda's reference is used to simply teach iron" (page 16, Id.). However, the Applicant respectfully submits that one of ordinary skill in the art at the time of the present invention would not have a reason to replace one material disclosed in one reference with another material disclosed in another reference, particularly when the other material has a different structure in a different field in order to achieve a different purpose. Namely, the conductive particle 214 of Yamazaki '127 is used for electrically connecting an input-output terminal 207 and a wiring 213 (see paragraph [0066]); whereas, the soft magnetic particles of Fujieda are used to absorb electromagnetic waves (see abstract). A generalized concern over cost reduction, as asserted in the Response to Arguments, is insufficient to explain why one of ordinary skill in the art at the time of the present invention would have replaced the gold-plating in Yamazaki with iron in order to achieve the features of the present claims.

In section 5 of the "Response to Argument" section, the Official Action asserts that "the degree of conductivity is not relevant, as long as the device still functions" (page 17, Id.). However, the Applicant respectfully submits that the possibility of a modified device not functioning, i.e. the creation of defective products as a result of the Examiner's hypothetical modifications of the prior art, is highly relevant to the question of whether it would have been obvious to use the anisotropic conductive material of Yamazaki compared to the use of pure metal in the via 108/110 of Reddy. Namely, Yamazaki's anisotropic conductive material has a particular type of conductivity, and the anisotropic function of that material should be considered when contemplating a combination with Reddy's pure metal. As noted in detail in the previous response, a change in the underlying functionality and intended purpose is highly relevant to the question of obviousness. Since the Examiner's proposed modification of Yamazaki appears to affect the underlying functionality and intended purpose, the proposed

modifications are non-obvious. Also, the Applicant respectfully submits that one of ordinary skill in the art would probably, in fact, try to reduce the possibility of defective products as much as possible; therefore, it is not at all clear why one of ordinary skill in the art at the time of the present invention would want to use the anisotropic conductive material in the via 108/110 of Reddy.

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Reddy, Yamazaki '127 and Fujieda or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness.

Furthermore, none of the references of record teach or suggest an insulating film or resin film over a conducting wire in an antenna, nor an insulating film or resin film adjacent to a side of a conducting wire in an antenna by interposing an insulating film therebetween (see pages 7-8 of the previous response for details as they pertain to each independent claim). In the present invention, this structure suppresses the loss of magnetic flux that intersects with a plane including an antenna, and increases the mutual inductance of the antenna, thereby, increasing the gain of the antenna while securing the mechanical strength of the ID chip (see paragraph [0014] of U.S. Publication No. 2007/01260681, which is the pre-grant publication of the present application). The Applicant respectfully submits that Reddy, Yamazaki '127 and Fujieda, either alone or in combination, do not teach or suggest the above-referenced

features of the present invention. Since Reddy, Yamazaki '127 and Fujieda do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,


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